

## **REMARKS**

Claims 1-6 are pending in this application. Claims 1-6 stand rejected. Claims 1 and 5 have been amended. Claims 7-9 are new.

Claims 7 and 9 recite the orientation of the poles of the magnet, and are supported by at least original claim 1.

Claims 8 corresponds to claim 5, directed, as suggested by the Examiner, to the field of use.

The title of the application has been amended to more precisely refer to the fixture and a method of loading.

The abstract has been amended as suggested by the Examiner.

No new matter has been added by these amendments.

### **35 U.S.C. § 112:**

Claims 1-4 were rejected on the ground that the term “fixturing” in claim 1 is unclear. The term “fixturing” has been replaced by the term “loading” which is also used in the description, see, for example, paragraph [0011], and which is believed to express the intended meaning of the claim.

### **35 U.S.C. § 103:**

Claims 1-6 stand rejected as obvious over U.S. Patent No. 3,660,949 (Coes) or U.S. Patent No. 4,837,540 (Michele). Coes and Michele show magnetic holders for workpieces. Coes shows a holder in which the north and south poles of an electromagnet are positioned on opposite sides of a container full of ferromagnetic particles. When the electromagnet is energized, the magnetic field passes through the container, locking the particles rigidly together, and trapping and holding any workpiece that has been placed therein. Michele shows an array of upstanding, resilient, pole pieces, with a ferromagnetic workpiece laid over, and held onto, several of the pole pieces.

The examiner acknowledges that neither Coes nor Michele discloses or suggests the stack of alternating discs recited in claims 1 and 5, but argues that “geometric configuration of the magnet is irrelevant as long as it holds the workpiece.” Applicants respectfully submit that such an argument is not a proper standard for a finding of obviousness.

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations.

The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, not in applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).

MPEP § 2143.

In the present case, the prior art references do not teach or suggest all the claim limitations. The examiner has not shown, or even alleged, that the prior art teaches or suggests a tube containing a stack of alternating iron and magnetic discs as a component of a magnetic holder, as recited in independent claims 1, 5 and 7.

Applicants submit that there is no suggestion or motivation found in the prior art to modify the references. Furthermore, the Examiner's argument would be an argument against modifying the references, because if the "geometric configuration of the magnet is irrelevant" there would be no reason not to retain the configuration taught by the references.

In fact, the geometric configuration of the magnet *is* relevant. As explained in paragraphs [0009] and [0010] of the specification, existing magnetic holders for PVD substrates have their limitations, and the magnetic holders of Coes and Michele would be wholly unsuitable for use in the PVD coating of cutting inserts. The geometric configuration of the magnet of the present invention provides a new and useful alternative that can offer significant advantages, at least for certain shapes of workpiece, as discussed in paragraphs [0018] and [0019] of the specification.

For all of the above reasons, it is respectfully submitted that the present invention, as claimed in all of independent claims 1, 5, and 7, would not have been obvious over the cited Coes and Michele references. Claims 2-4, 6, 8, and 9 are dependent from claims 1, 5, and 7 and, without prejudice to their individual merits, are deemed non-obvious for the same reasons as their respective main claims.

Further, the office action states at page 4, line 8, that "the limitations of claims 2-6 have been addressed above." However, at least claims 2-4, 6, and 8 recite features of

structure that are nowhere mentioned in the office action. For this reason also, at least claims 2-4, 6, and 8 are deemed non-obvious over Coes and Michele.

Claim 5 is rejected as obvious over U.S. Patent No. 5,557,487 (Elsaesser). The Examiner cites Elsaesser as showing “a disk storage drive in which a stack of discs are disposed within a tube (Figure 1) in which the storage disk is non ferromagnetic (col. 1, line 54).... The reference teaches that the disks are stored.” The Examiner argues that “it appears to be irrelevant what material the disks are as long as the disks can fit in the storage area. Hence, it would have been obvious to store magnetic and iron disks.” As the Federal Circuit has recently explained in *Phillips v. AWH Corp.*, 75 USPQ2d 1321 (Fed. Cir. *in banc* 2005), when interpreting terms in a patent it is important to “look at the ordinary meaning in the context of the written description” and to avoid “the adoption of a dictionary definition entirely divorced from the context.” The Examiner appears to have been misled in interpreting Elsaesser by an incorrect reading of the expression “disk storage drive.”

The disks in the present invention are magnetic material and iron that are arranged in alternating order and stacked within a tube of a non-magnetic metallic material. The combination forms a fixture that can be used to hold cutting inserts in Physical Vapor Deposition coating equipment.

The “Disk storage drive” shown in Figure 1 of Elsaesser is a drive motor for a magnetic-disk data-storage device, (classified in Class 360/99.08, Dynamic Magnetic Information Storage or Retrieval - Record Transport with Head Stationary During Transducing - Disk record - Plural disks - Seating of disks). The actual magnetic disks, identified as 139 in Figure 6, would be attached to the hub 25 on the outside of the motor assembly shown in Figure 1. The Examiner does not identify the components in Figure 1 that he identifies as “a stack of disks ... disposed within a tube.” The nearest that can be identified is the stator lamination 48 within the shielding can 26. The stator lamination is, of course, a stack of iron laminae that are probably not very disk-shaped (see the plan view of stator laminae identified as 110 in Figure 5). “The shielding can 26 is made from a ferromagnetic material,” col. 3, lines 33-34. The non-ferromagnetic component referred to at col. 1, line 54 is “at least the part of the casing receiving the storage disk,” col. 1, line 53. In Figure 1, the hub 25 forms a cap over the ferromagnetic shielding can 26, see col. 3, lines 25-29. As such, Elsaesser does not teach a tube of a non-magnetic metallic material in

which alternating disks are stored. Instead, Elsaesser teaches that disks 139 are used for storage of data, col. 8, lines 38-39. Thus, there is nothing in Elsaesser that would suggest to a person of ordinary skill in either Elsaesser's art or the present inventors' art to use Elsaesser's motor to function as a fixture for holding cutting inserts in PVD coating equipment.

Accordingly, there is nothing in Elsaesser that would suggest constructing a stack comprising alternating disks of magnetic material and iron within a tube of non-magnetic material, as recited in claim 5. Thus, claim 5 is believed to be non-obvious over Elsaesser. New claim 7 depends from claim 5 and recites the orientation of the poles of the magnets. Clearly this is not shown nor suggested in Elsaesser. Accordingly, claim 7 is patentable over Elsaesser.

New independent claim 8 specifically defines the use of the fixture for holding inserts inside PVD coating equipment. Elsaesser is completely unrelated to this use and thus, is non-analogous art. For this reason alone, claim 8 is patentable over Elsaesser. Claim 9 depends from claim 8 and recites the orientation of the poles of the magnets. As with claim 7, claim 9 is patentable over Elsaesser.

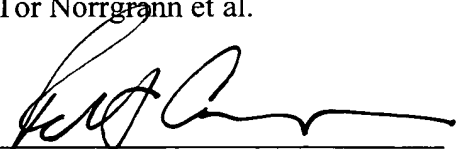
***Conclusion:***

In view of the foregoing, reconsideration of the examiner's rejections and an early notice of allowance of all of claims 1-9 are earnestly solicited.

Respectfully submitted,

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